

## **REMARKS/ARGUMENTS**

Claim 51 is pending in the present application. Claims 1-50 were previously canceled; claim 51 was amended; and claims 52-60 were added. Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 103, Obviousness**

The Examiner has rejected claim 51 under 35 U.S.C. § 103 as being unpatentable over Rourke et al., U.S. Patent No. 5,995,721 (hereinafter Rourke) in view of Patton, U.S. Patent No. 7,265,855 (hereinafter Patton). Final Office Action pp. 4-10. This rejection is respectfully traversed.

#### **A. Amendments and New Claims**

Support for new claims 52 through 58 is found in the specification and drawings as follows:

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| 52. (New) The method of claim 51 wherein the specific printer is a printer containing letterhead paper.  | Page 10, lines 17; FIG. 8, 708   |
| 53. (New) The method of claim 51 wherein the specific printer is a photographic printer.   | Page 10, lines 17; FIG. 8, 714   |
| 54. (New) The method of claim 51 wherein the specific printer is enabled to print fonts or images unprintable by other printers in the plurality of printers.  | Page 10, lines 18.   |
| 55. (New) The method of claim 51 further comprising:<br><br>wherein the data hidden in each document is an embedded file header that describes a plurality of printable document data and indicates whether a document contains a specific printer direction in a page of the document; and<br><br>when the data contains a specific printer direction, sending the page to a specific printer; and<br><br>wherein a specific printer is a closest printer to a user's computer, a printer at a specific physical location, a printer having | FIG. 4, 208;<br>Page 6, lines 9-12;<br>Page 10, line 21 to page 11, lines 2;<br>Page 10, lines 15-20; and<br>Page 12, lines 4-9. |

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| special sophisticated fonts, a printer having special embedded graphics, a printer requiring very high resolution, a printer containing photographic quality glossy paper, a printer containing perforated pages, a printer containing company letterhead, or a printer specifically designated by the user.  |   |
| 56. (New) The method of claim 51 wherein the data hidden in each document is an embedded file header that indicates a document size, a document type, a text type, a text color, a graphic type, a graphic color, a priority of a print job, a page size, a page format characteristics, or a document resolution requirement.  | FIG. 4, 208<br>Page 6, lines 9-12; and<br>Page 10, lines 15-21.   |
| 57. (New) The method of claim 51 wherein, when reassembling the documents is to be performed manually, a control page is printed that informs the user of the physical location of each the printers that printed separated parts of the original document.   | Page 18, lines 4-8.   |
| 58. (New) The method of claim 51 wherein the printed document pages are reassembled by an automated process.  | FIG. 8, 724; and<br>Page 18, line 9.  |
| <p>59. (New) A method for printing a document using a computer connected to a plurality of printers comprising:</p> <p style="padding-left: 20px;">processing a print queue by separating each of a plurality of documents into a plurality of document pages each having a document page data hidden in the page;</p> <p style="padding-left: 20px;">analyzing only the document page data in each of the plurality of document pages, and responsive to a determination that the document page data requires a specific printer, sending the document page to a specific printer queue;</p> <p style="padding-left: 20px;">wherein the specific printer is enabled to print fonts or images unprintable by other printers in the plurality of printers.</p> | FIG. 4;<br>Page 4, lines 9-11;<br>Page 6, lines 9-12;<br>Page 10, lines 14-16; and<br>Page 10, lines 17-18. |
| 60. (New) The method of claim 59 wherein the specific printer contains letterhead paper.  | FIG. 8, 708;<br>Page 10, line 17.   |

Applicants submit that the new limitations below distinguish over the prior art:

- the specific printer is a printer containing letterhead paper.
- the specific printer is a photographic printer.
- the specific printer is enabled to print fonts or images unprintable by other printers in the plurality of printers.
- wherein the data hidden in each document is an embedded file header that describes a plurality of printable document data and indicates whether a document contains a specific printer direction in a page of the document.
- wherein a specific printer is a closest printer to a user's computer, a printer at a specific physical location, a printer having special sophisticated fonts, a printer having special embedded graphics, a printer requiring very high resolution, a printer containing photographic quality glossy paper, a printer containing perforated pages, a printer containing company letterhead, or a printer specifically designated by the user.
- wherein the data hidden in each document is an embedded file header that indicates a document size, a document type, a text type, a text color, a graphic type, a graphic color, a priority of a print job, a page size, a page format characteristics, or a document resolution requirement.
- wherein, when reassembling the documents is to be performed manually, a control page is printed that informs the user of the physical location of each the printers that printed separated parts of the original document.
- wherein the printed document pages are reassembled by an automated process.
- processing a print queue by separating each of a plurality of documents into a plurality of document pages each having a document page data hidden in the page and analyzing only the document page data in each of the plurality of document pages.

**B. Whether Rourke and Patton discloses the limitation “analyzing only a document page data in each of the plurality of document pages to determine a required printer type”**

Rourke's job ticket disclosed at 7:20-31 includes attribute information and controls the printing of a document. Claim 51 has been amended to recite using “only” the hidden metadata. Claim 51 does not require a job ticket but controls printing using only the hidden metadata in the

document page. Support for the amendment is found in the specification page 10, line 12 to page 11, line 2. Since claim 51 does not require a job ticket, but only the hidden metadata, claim 51 distinguishes over Rourke.

**C. Whether Rourke and Patton disclose “a queue for a specific printer”**

Rourke 8:65-9:4 discloses only a black/white printer and two types of color printers. Rourke is silent as to a queue for a specific printer. The Examiner noted that while Applicants argued that a specific printer contained letterhead, the limitation was not in the claim and the Examiner did not respond. Claims 52, 53, 54, 55 and 59 recite specific limitations regarding specific printers.

**D. Whether Rourke and Patton are properly combinable**

1. An explicit analysis is required.

In combining references, an explicit analysis is required to combine or modify references. The Supreme Court has stated the following:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). [R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*KSR Int'l v. Teleflex Inc.* 127 S.1727, 1740-41 (2007). Conclusory statements are insufficient to support obviousness rejections. In particular, “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006).

The Examiner responded to Applicants' arguments that Rourke and Patton were not properly combinable by stating that the suggestion to combine would "have been to easily manage and organize the system and to have a reliable system which permits job interruption when priority is desired without manually finishing the interrupted job." The Examiner cites to column 2, lines 23-35. As can be seen, an express analysis has not been provided in the Examiner's reasons for combining the references. The statements made by the Examiner do not provide reasons as required in the Supreme Court guidance on combining references in the KSR case. Instead, the Examiner has only provided statements that are conclusory or reciting some desired goal. These conclusions and desired goals have not been supported with any explicit analysis or articulated reasoning with some rationale underpinnings to support the conclusions or goals for combining the elements in these two references in the manner proposed by the Examiner. Further, even if these conclusory statements or goals could be considered "reasons", they do not have any articulated reasoning with some rational underpinning to support the examiners assertion of obviousness

2. The Examiner did not provide an explicit analysis.

The Examiner has merely offered a goal or desire to easily manage and organize the system and to have a reliable system which permits job interruption when priority is desired without manually finishing the interrupted job. To meet this goal, the Examiner states it would have been obvious to combine Rourke and Patton. Nowhere, however, has the Examiner gone beyond this conclusion or desired goal to explain sufficiently why one of ordinary skill in the art would have combined these two references. Moreover, the Examiner did not respond to Applicants' argument that Patton's control system would be fatally defective in the context of Rourke's teaching. (Response to Office Action, page 8). This is reflected in the Examiner's statement of a goal rather than an explanation of how the mechanism of the mechanism of Rourke could be improved by adding a mechanism from Patton. Applicants' point is that they and an explanation is set forth on page 7-8 of the prior office action. Applicants' request a response directed to the mechanics of Rourke and Patton discussed by Applicants.

Therefore, the rejection of claim 51 under 35 U.S.C. § 103 has been overcome.

## **II. Conclusion**

It is respectfully urged that the subject application is patentable over Rourke in view of Patton and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/Rudolf O. Siegesmund/

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